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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,792	12/12/2003	Erwan Hacker	514413-3869.1	3467
20999 7590 10/14/2009 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151				
EXAMINER QAZI, SABITA NAIM				
ART UNIT 1612		PAPER NUMBER		
MAIL DATE 10/14/2009		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

Application No.	Applicant(s)	
10/734,792	HACKER ET AL.	
Examiner	Art Unit	
Sabiha Qazi	1612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 7/6/09
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 3,6-9 and 12-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3,6-9 and 12-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other \_\_\_\_\_

**Final Office Action**

Claims 3, 6-9, 12-22 are pending. No claim is allowed at this time.  
Amendments are entered.

**Summary of this Office Action Thursday October 8, 2009**

1. Election of Species
2. Information Disclosure Statement
3. Copending Applications
4. Specification
5. 35 USC § 112 --- First Paragraph Written Description Rejection
6. 35 USC § 112 --- First Paragraph Scope of Enablement Rejection
7. 35 USC § 103 (a)---Rejections
8. Response to Remarks
9. Conclusion
10. Communication

**Election of Species--- (Examiner Mark Clardy). New election of species is not accepted.**

The response filed July 25, 2002, applicants elected the composition comprising the following herbicides:

**A2.**

N-(1-cyclopropyl-4-phenylbutyl)-6-(1-fluoro-1-methylethyl)-1, 3,5-triazine-2,4-diamine

**B1.3.3**

Fenoxaprop.

This election will be maintained herein.

Applicant argues in remarks filed on 10/7/08 that A1 and A2 are equivalent.

Examiner disagrees that A1 and A2 are equivalent. They are different compounds. See the structures in claim 21. Elected species was A2 in combination with B1.3.3. The status is same. Elected species will not be changed and will remain the same. See office action mailed on 3/14/2006 by Examiner Mark Clardy where the election was the combination of A2 and B1.3.3.

See remarks filed on 9/14/06. Never A1 was elected. Applicant is not allowed to change the species during the prosecution.

Restriction is made FINAL

Elected species is not allowed.

### **Information Disclosure Statement**

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or

other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### **Copending Applications**

Applicants must bring to the attention of the examiner, or other Office official involved with the examination of a particular application, information within their knowledge as to other copending United States applications, which are "material to patentability" of the application in question. MPEP 2001.06(b). See *Dayco Products Inc. v. Total Containment Inc.*, 66 USPQ2d 1801 (CA FC 2003).

### **Specification**

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### **35 USC § 112 --- First Paragraph Written Description Rejection**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3, 6-9, 12-22 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Following reasons apply:

The specification has no guidance how all the heterocyclic groups can be prepared and will be useful for such broad combinations as has been claimed. It appears that Applicant has no possession of the claimed subjected as whole at the time the application was filed.

The term “derivative” used in claims 3 and 21.

The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See, e.g., In re Wilder, 22 USPQ 369, 372-3 (Fed. Cir. 1984). (Holding that a claim was not adequately described because the specification did ‘little more than outline goals appellants hope the claimed invention achieves and the problems the invention will hopefully ameliorate.’)

Mere indistinct terms such as “derivatives” used herein, however, may not suffice to meet the written description requirement. This is particularly true when a compound is claimed in purely functional terms. See Univ. of Rochester v. G.D.

Searle, 69 USPQ2d 1886 (CAFC 2004) at 1892, stating:

The appearance of mere indistinct words in a specification or a claim, even an original claim, does not necessarily satisfy that requirement. A description of an anti-inflammatory steroid, i.e., a steroid (a generic structural term) described even in terms of its functioning of lessening inflammation of tissues fails to distinguish any steroid from others having the same activity or function. A description of what a material does, rather than of what it is, usually does not suffice.... The disclosure must allow one skilled in the art to visualize or recognize the identity of the subject matter purportedly described. (Emphasis added).

Conversely, a description of a chemical genus will usually comprise a recitation of structural features common to the members of the genus, which features constitute a substantial portion of the genus. See Univ. of Calf. V. Eli Lilly, 43 USPQ 2d 1398, 1406 (Fed. Cir. 1997). This is analogous to enablement of a genus under Section 112, ¶ 1, by showing the enablement of a representative number of species within the genus.

A chemical genus can be adequately described if the disclosure presents a sufficient number of representative species that encompass the genus. If the genus has substantial variance, the disclosure must describe a sufficient number of species to reflect the variation within that genus. See MPEP 2163. The MPEP lists factors that can be used to determine if sufficient evidence of possession has been furnished in the disclosure of the Application. These include the level of skill and knowledge in the art, partial structure, physical and/or chemical properties,

functional characteristics alone or coupled with a known or disclosed correlation between structure and function, and the method of making the claimed invention. Disclosure of any combination of such identifying characteristics that distinguish the claimed invention from other materials and would lead one of skill in the art to the conclusion that the applicant was in possession of the claimed species is sufficient. MPEP 2163.

Here, the specification does not provide a reasonably representative disclosure of useful as synergistic combination generally, a potentially huge genus inclusive of many different compounds having widely divergent structures and functions.

The data presented in the specification examples I-22 (pages 68 to 86) has been considered. The synergism cannot be predicted for all the combinations as claimed. In the present case sulfonyl urea compounds of formula II, III, IV and V as in claim 19 include thousands of compounds including for example heterocycl radical or heterocyclamino radical having in each case 3-6 ring atoms and 1 to 3 hetero ring atoms selected from N, O, or R2 and R3 together with nitrogen atom of the NR2R3 are a heterocyclic radical having 3 to 6 ring atoms and 1 to 4 hetero ring atoms where the further hetero ring atoms which are optionally present in addition to nitrogen atom are selected from N, O, and S (definition of R2 and R3) which are combined with component (B) which also includes hundreds of compounds as listed in claims such as in claims 19, 14, 15. There is no guidance for such Markush group of synergistic combinations.

Applicant has no possession of the invention of the subject matter for synergistic combinations as claimed at the time of filing the application.



**35 USC § 112 — First Paragraph Scope of Enablement Rejection**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

*The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.*

Claims 2-4, 6-9 and 11-22 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the two compounds combination of A1 and A2 and does not reasonably provide enablement of the synergistic combination of compounds of all the formulas as claimed.

The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

The factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. 112, first paragraph, have been described in *In re Wands*, 8 USPQ2d 1400 (Fed. Cir. 1988). Among these factors are: (1) the nature of the invention; (2) the state of the prior art; (3) the relative skill of those in the art; (4) the predictability or unpredictability of the art; (5) the breadth of the claims; (6) the amount of direction or guidance presented; (7) the presence or absence of working examples; and (8) the quantity of

experimentation necessary. When the above factors are weighed, it is the examiner's position that one skilled in the art could not practice the invention without undue experimentation. Following reasons apply:

### **The predictability or unpredictability of the art**

There is a lack of predictability in the art. It is not possible to predict the synergistic combinations for Markush group of combinations. The combinations as presently claimed would not be a routine experimentation for one who is skilled in the art. For example the references cited for the herbicides A does not contain such a broad range of compounds.

### **The amount of direction or guidance presented**

There is no guidance and/or direction provided for the combination of such a broad range of compounds having synergism. The specification has no guidance how all the heterocyclic groups can be prepared and will be useful for such broad combinations as has been claimed. Specification does not also disclose how to make and use of such a large genus of herbicides A which includes large number of heterocyclic compounds.

The inventor provides very little direction in the instant specification. Only limited substituents on the compounds are made and disclosed. There are no compounds R2 and R3 forming a ring. The availability of the starting material that is needed to prepare the invention as claimed is also at issue here.. As per MPEP 2164.01 (b): A key issue that can arise when determining whether the specification is enabling

is whether the starting materials or apparatus necessary to make the invention are available. In the biotechnical area, this is often true when the product or process requires a particular strain of microorganism and when the microorganism is available only after extensive screening. The Court in In re Ghiron, 442 F.2d 985,991,169 USPQ 723,727 (CCPA 1971), made clear that if the practice of a method requires a particular apparatus, the application must provide a sufficient disclosure of the apparatus if the apparatus is not readily available. The same can be said if certain chemicals are required to make a compound or practice a chemical process. In re Howarth, 654 F.2d 103, 105,210 USPQ 689, 691 (CCPA 1981). There is no starting material provided with respect to the various substituents.

### **The presence or absence of working examples**

A disclosure should contain representative examples, which provide reasonable assurance to one skilled in the art that the compounds fall within the scope of a claim will possess the alleged activity. See In re Riat et al. (CCPA 1964) 327 F2d 685, 140 USPQ 471; In re Barr et al. (CCPA 1971) 444 F 2d 349, 151 USPQ 724.

The specification does not provide a reasonably representative disclosure of useful as synergistic combination generally, a potentially huge genus inclusive of many different compounds having widely divergent structures and functions.

The data presented in the specification examples I-22 (pages 68 to 86) has been considered. The synergism cannot be predicted for all the combinations as claimed. In the present case sulfonyl urea compounds of formula II, III, IV and V

as in claim 19 include thousands of compounds including for example heterocycl radical or heterocyclamino radical having in each case 3-6 ring atoms and 1 to 3 hetero ring atoms selected from N, O, or R2 and R3 together with nitrogen atm of the NR2R3 are a hetrocyclic radical having 3 to 6 ring atoms and 1 to 4 hetero ring atoms where the further hetero ring atoms which are optionally present in addition to nitriogen aatom are selected from N, O, and S (definition of R2 and R3) which are combined with componenet (B) which also includes hundreds of compounds as listed in claims such as in claims 19, 14, 15. There is no guidance for such Markush group of combinations.

### **The quantity of experimentation necessary**

There is no guidance and/or direction provided by the Applicants for the wide variety of the combinations as claimed. One skilled in the art would have to go through undue experimentation to make and/or use the instant invention. The instant specification does not have working examples with respect to the various substituents as given above. The state of the art indicates that even when the reactants are similar, and the reaction conditions are the same, it is not necessary that it would form the same products.

### **Claim Rejections - 35 USC § 103**

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- I. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3, 6-9, 12-22 rejected under 35 U.S.C. 103(a) as being unpatentable over **GIENCKE** et al. (US Patent 6,239,071), **HOECHST** (PCT 98/34925), **HIRATA** et al. (A: EP 0 467 204; B: 0 469 406; D: C: 0 47 221; EP 0 471 284), **TAKEMATSU** (abstract of JPO Publication 04095003, **IDEMITSU** (A: Abstract of JP 7267804; B: abstract of JP 7267805) and **Applicant's disclosure (page 27)**.

It is noted that applicants have stated on the record that the aminotriazinyl herbicides herein are known and that they have been described in the prior art (specification, p. 27).

Giencke et al teach that aminotriazine herbicides may be combined with a large number of secondary herbicides (columns 18-20).

Hoechst teaches also that aminotriazine herbicides may be combined with various other herbicides (p. 36-38).

Hirata et al (A) teach the synergistic combination of aminotriazine herbicides with urea herbicides.

Hirata et al (B) teach the synergistic combination of aminotriazine herbicides with benzoic acid or pyridine carboxylic acid herbicides.

Hirata et al (C) teach the synergistic combination of aminotriazine herbicides with thiocarbamate herbicides (formula II).

Hirata et al (D) teach the synergistic combination of aminotriazine herbicides with sulfonylurea herbicides.

Takematsu teaches the **combination of aminotriazine herbicides with dinitroaniline herbicides for selective weed control.**

**Idemitsu (A) teaches the synergistic combination of aminotriazine herbicides with prodiamine, dithiopyr, halosulfuron, triclopyr, napropamid, bensulide, propyzamide, flazasulfuron, imazosulfuron, and imazaquin.**

**Idemitsu (B) teaches the synergistic combination of aminotriazine herbicides with pyrazosulfuron-ethyl, MCPP, pendimethalin, besulodine, and simazine.**

One of ordinary skill in the art would be motivated to combine the teachings of these references because they teach the herbicidal utility of aminotriazine compounds in combination with a variety of secondary herbicides.

Thus it would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have combined applicants' aminotriazine herbicides with a second herbicidal agent, to make a herbicidal composition because a wide variety of such combinations has been shown by the cited prior art to result in synergistic compositions. Further, it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition that is to be used for the very same purpose; the idea of combining them flows logically from their having been individually taught in the prior art. In re Kerkhoven, 205 USPQ 1069. Determination of appropriate concentration ranges would have been within the skill level of the ordinary artisan.

As has been decided by the court, a combination, for the same purpose, of one additive explicitly disclosed in the prior art and another suggested by the prior art is at least prima facie obvious. In re Susi, 169 USPQ 423. There is nothing inventive in a composition of old ingredients of known properties with each ingredient functioning individually as expected. In re Sussaman 58 USPQ 262.

Furthermore, because of each compound appears to be well known in the prior art, it would appear that the combination of the compounds would have been obvious in view of MPEP 2144.06 and see Ex parte Quadranti, 25 USPQ2d 1071 (Bd. Pat. App. & Inter. 1992).

In Ex parte Quadranti where it was held that

"Use of materials in combination, each of which is known to function for intended purpose, is generally held to be prima facie obvious, and in instant case, use of combination of herbicides is so notoriously well known as to be capable of being taken by official notice; generalizations such as Colby formula are not particularly useful in determining whether synergism has been demonstrated, since formula inherently results in expectation of less than additive effect for combination of herbicides, since there is no evidence that such approach is considered valid by significant number of ordinarily skilled workers in relevant area of technology, and since it could be reasonably argued that in most cases, additive or better than additive results could be expected for combination of herbicides."

"There is no single, appropriate test for determining whether synergism has been demonstrated for chemical combination; rather, facts shown in each case must be analyzed to determine whether chosen method has clearly and convincingly demonstrated existence of synergism or unobvious result".

"Assuming arguendo that the differences in values presented are statistically significant, there is no evidence that they represent a true, practical advantage. In re Freeman, **474 F.2d 1318, 177 USPQ 139** (CCPA 1973); In re Klosak , **455 F.2d 1077, 173 USPQ 14** (CCPA 1972); In re D'Ancicco, **439 F.2d 1244, 169 USPQ 303** (CCPA 1971). Also, prescinding from the Colby formula test, which as we have already indicated is at best controversial and in our view probably invalid, there is no evidence that the differences are unexpected. In re Merck, **800 F.2d 1091, 231 USPQ 375** (Fed.Cir. 1986); In re Longi , **759 F.2d 887, 225 USPQ 645** (Fed.Cir. 1985); In re Freeman, supra" .



### **Data in the Specification**

The data presented in the specification examples 1-22 (pages 68 to 86) are not considered synergistic. See *Ex parte Quadranti*. Furthermore, synergism cannot be predicted for all the combination as claimed. In the present case sulfonyl urea compounds of formula I include large number of compounds which are combined with (B) which also includes hundreds of compounds as listed in claims such as in claims 19, 14, 15. Therefore, results presented in the specification are not considered synergistic and do not represent the combination of whole genus as claimed. The combination of known herbicides would have been obvious to one skilled in the art. Specification discloses that all the compounds are known.

As has been established that a single species is seldom, if ever, sufficient to support a generic claim. In *re Shokal*, 242 F.2d 771, 113 U.S.P.Q. 283, 285 (C.C.P.A. 1957). See also, In *re Grimme*, 274 F.2d 949, 124 U.S.P.Q. 499, 501 (C.C.P.A. 1960) (the naming of a member of a genus or subgenus is not a proper basis for claiming the whole group).

Objective evidence of nonobviousness must be commensurate in scope with the scope of the claims. In *re Tiffin*, 171 USPQ 294. A showing limited to a single species can hardly be considered probative of the invention's nonobviousness in view of the breadth of the claims.

**Because each of the herbicides are well-known in the prior art, it would appear that the combination as claimed would have been obvious in view of MPEP 2144.06 and particularly in view of *Ex parte Quadranti*, 25 USPQ2d 1071 (Bd. Pat. App. & Inter. 1992) where it was**

**held that “the use of combinations of herbicides is so notoriously well known as to be capable of being taken together by the official notice.”**

See *In re Kollman*, 595 F.2d 48, 201 USPQ 193 (CCPA 1979) (Claims directed to a synergistic herbicidal composition comprising mixtures of an herbicide known as “FENAC” with a diphenyl ether herbicide in certain relative proportions were rejected as prima facie obvious. Appellant presented evidence alleging unexpected results testing three species of diphenyl ether herbicides over limited relative proportion ranges. The court held that the limited number of species exemplified did not provide an adequate basis for concluding that similar results would be obtained for the other diphenyl ether herbicides within the scope of the generic claims. Claims 6-8 recited a FENAC:diphenyl ether ratio of 1:1 to 4:1 for the three specific ethers tested. For two of the claimed ethers, unexpected results were demonstrated over a ratio of 16:1 to 2:1, and the effectiveness increased as the ratio approached the untested region of the claimed range. The court held these tests were commensurate in scope with the claims and supported the nonobviousness thereof. However, for a third ether, data was only provided over the range of 1:1 to 2:1 where the effectiveness decreased to the “expected level” as it approached the untested region. This evidence was not sufficient to overcome the obviousness rejection.); *In re Lindner*, 457 F.2d 506, 509, 173 USPQ 356, 359 (CCPA 1972) (Evidence of nonobviousness consisted of comparing a single composition within the broad scope of the claims with the prior art. The court did not find the evidence sufficient to rebut the prima facie case of obviousness because there was “no adequate basis for reasonably concluding that the great number and variety of compositions included in the claims would behave in the same manner as the tested composition.”).

In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a).

#### **Data in Specification**

The data presented in the specification examples I-22 (pages 68 to 86) has been considered. The data does not commensurate with the scope of the claimed subject matter. Furthermore, synergism cannot be predicted for all the combinations as claimed. In the present case sulfonyl urea compounds of formula II, III, IV and V as in claim 19 include thousands of compounds including for example heterocyclyl radical or heterocyclylamino radical having in each case 3-6 ring atoms and 1 to 3 hetero ring atoms selected from N, O, or R2 and R3 together with nitrogen atom of the **NR2R3** are a heterocyclic radical **having 3 to 6 ring atoms and 1 to 4 hetero ring atoms** where the further hetero ring atoms which are optionally present in **addition to nitrogen atom are selected from N, O, and S (definition of R2 and R3)** which are combined with component (B) which also includes hundreds of compounds as listed in claims such as in claims 19, 14, 15.

#### **Response to Remarks**

**Applicants' arguments, filed 7/6/09, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are**

**either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.**

Examiner notes, that Applicant has drawn the structures of A1 and A2. This supports the Examiner's position that it is not the same species. Applicant tried to change the election from A2 to A1 which is not allowed. Applicant must note that this is not about restriction in groups and is about the election of species. During the prosecution Applicant is not allowed to change the species. Examiner disagreed in that elected compound A2 is equivalent to A1. These two compounds are different and are not the same species. There class in classification system is same but the species is not the same. This Compound (A2) is elected in combination of B1.3.3. The election was repeated on page 3 of the previous office action and is as follows:

**Election of Species---** (Examiner Mark Clardy). **New election of species is not accepted.**

The response filed July 25, 2002, applicants elected the composition comprising the following herbicides:

**A2.**

N-(1-cyclopropyl-4-phenylbutyl)-6-(1-fluoro-1-methylethyl)-1, 3,5-triazine-2,4-diamine

**B1.3.3**

Fenoxaprop.

This election will be maintained herein.

Applicant argues in remarks filed on 10/7/08 that A1 and A2 are equivalent. Examiner disagrees that A1 and A2 are equivalent. They are different compounds. See the structures in claim 21. Elected species was A2 in combination with B1.3.3. The status is same. Elected species will not be changed and will remain the same. See office action mailed on 3/14/2006 by Examiner Mark Clardy where the election was the combination of A2 and B1.3.3. See remarks filed on 9/14/06. Never A1 was elected. Applicant is not allowed to change the species during the prosecution.

Restriction is made FINAL

Elected species is not allowed. See the structures in claim 21. Details have been discussed in "election of species".

**Applicant argues and compared the European Patent Convention (EPC) Article and US patent law 35 U.S.C. (on page 26 of the remarks. Examiner disagrees with any of such type of comparison with an article and US 35 USC. Examiner will follow the laws for the examination of an application according to US patent laws system and decisions are taken accordingly.**

Arguments regarding written description rejection are not found persuasive because examples 11 and 22 are of A1 and not of A2 which is the elected species. Furthermore, the combination has been tested against *Capselle bursapastoris*. Elected combination is not allowable. Further, the term derivative is considered broad it may include any compound known or unknown. Deletion of this term is suggested. The written description has been completely addressed and

maintained. It appears that Applicant has no possession of the claimed subject as whole at the time the application was filed.

Election of species has been addressed in the beginning of the office action.

Applicant argues that it is not clear what has been said about IDS. Examiner will consider only those references which are cited in 1449. If the reference is any other language other English Applicant is requested to submit it's abstract to be considered. Reference cited in the specification should be submitted in the form 1449 with the copies in order to be considered.

The combination of herbicides as claimed has been taught by the prior art. Applicants own specification discloses that the compounds are known. The combination of the compounds as has been claimed would have been therefore obvious to one skilled in the art. Rejection under 103 is maintained for the same reasons as set forth in the previous office action because arguments are not found persuasive. Examiner believes that since each compound appears to be well known in the prior art, it would appear that the combination of the compounds would have been obvious in view of MPEP 2144.06 and see Ex parte Quadranti, 25 USPQ2d 1071 (Bd. Pat. App. & Inter. 1992). See MPEP 2144. In Ex parte Quadranti where it was held that use of materials in combination, each of which is known to function for intended purpose, is generally held to be prima facie obvious, and in instant case, use of combination of herbicides is so notoriously well known as to be capable of being taken by official notice; generalizations such as Colby formula are not particularly useful in determining whether synergism has been demonstrated, since formula inherently results in expectation of less than additive effect for combination of herbicides, since there is no evidence that such

approach is considered valid by significant number of ordinarily skilled workers in relevant area of technology, and since it could be reasonably argued that in most cases, additive or better than additive results could be expected for combination of herbicides.

See *In re Kollman*, 595 F.2d 48, 201 USPQ 193 (CCPA 1979) (Claims directed to a synergistic herbicidal composition comprising mixtures of an herbicide known as "FENAC" with a diphenyl ether herbicide in certain relative proportions were rejected as prima facie obvious. Appellant presented evidence alleging unexpected results testing three species of diphenyl ether herbicides over limited relative proportion ranges. The court held that the limited number of species exemplified did not provide an adequate basis for concluding that similar results would be obtained for the other diphenyl ether herbicides within the scope of the generic claims. Claims 6-8 recited a FENAC:diphenyl ether ratio of 1:1 to 4:1 for the three specific ethers tested. For two of the claimed ethers, unexpected results were demonstrated over a ratio of 16:1 to 2:1, and the effectiveness increased as the ratio approached the untested region of the claimed range. The court held these tests were commensurate in scope with the claims and supported the nonobviousness thereof. However, for a third ether, data was only provided over the range of 1:1 to 2:1 where the effectiveness decreased to the "expected level" as it approached the untested region. This evidence was not sufficient to overcome the obviousness rejection.); *In re Lindner*, 457 F.2d 506, 509, 173 USPQ 356, 359 (CCPA 1972) (Evidence of nonobviousness consisted of comparing a single composition within the broad scope of the claims with the prior art. The court did not find the evidence sufficient to rebut the prima facie case of obviousness because there was "no adequate basis for reasonably

concluding that the great number and variety of compositions included in the claims would behave in the same manner as the tested composition."").

Examiner respectfully concludes and submits that in view of the prior art, and Applicants own disclosure and for the reasons cited above, claims and specification does not provide any new concept or invention and would have prima facie obvious to one skilled in the art at the time the invention was filed. See in re Kollman.

### ***Conclusion***

I. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### **Communication**



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha Qazi whose telephone number is (571) 272-0622. The examiner can normally be reached on any business day except Wednesday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Krass Frederick can be reached on (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sabiha Qazi/

Primary Examiner, Art Unit 1612